

PATENT
Docket No. 12584.37
Customer No. 000027683

III. REMARKS/ARGUMENTS

A. Status of the Application

Claims 1 - 17 are pending herein. Claims 1, 3-8, 10-12 and 14-17 are amended. Reconsideration of this application in light of the following remarks is respectfully requested.

B. Objection to the Drawings

The drawings stand objected to under 37 CFR §1.83(a) for allegedly not showing every feature of the invention shown in the claims. Specifically, the objection states that the "hollow cylindrical sleeve" of claim 3 must be shown or the feature cancelled from the claim. The objection to the drawings is respectfully traversed.

The "hollow cylindrical sleeve" recited in claim 3 is clearly shown as item 32 in FIG. 1. Nevertheless, the term "hollow cylindrical sleeve" has been deleted from claim 3.

In light of the foregoing amendments and remarks, it is respectfully requested that the objection to the disclosure be withdrawn.

C. Rejection under 35 U.S.C. § 112

Claims 1-17 stand rejected under 35 U.S.C. §112, first paragraph. Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

The claims as originally filed were clearly enabled by the written description provided in the specification. Nevertheless, in order to clarify the claims, the claims have been amended to recite a "first movable sleeve."

In light of the foregoing, it is respectfully requested that the rejection of claims 1-17 under 35 U.S.C. §112, first paragraph be withdrawn.

D. Rejections Under 35 U.S.C. §103(a)

Claims 1-3, 5, 9-10 and 12-17 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,832,656 to Fournier, Jr. et al. ("Fournier '656") in view of U.S. Patent No. 5,794,703 to Newman et al. ("Newman '703"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

According to MPEP § 2142, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

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the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP § 2142 at 2100-124. If even one of these criteria is not met, then the prima facie case fails.

Applicant traverses the rejection of claims 1-3, 5, 9-10 and 12-17 over Fournier '656 in view of Newman '703 on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to independent claims 1, 10 and 15 and claims 2-3, 5, 9, 12-14 and 16-17 which depend thereon.

Claim 1, as amended, is directed to a downhole tool for attachment in a production string in a well bore having a casing. The tool includes a tubular housing having a fluid passage, a first movable sleeve coupled to the exterior of the housing, an actuating device coupled to the first movable sleeve that includes a plurality of scissor arms, and a valve in communication with the first fluid passage. The first movable sleeve is adapted to substantially block a flow of fluid through the first fluid passage when the first movable sleeve is in a closed position and to allow the flow of fluid when the first movable sleeve is in an open position. In response to a first predetermined condition, the scissor arms of the actuating device move laterally causing the first movable sleeve to move longitudinally from the closed position to the open position. Upon the occurrence of a second predetermined condition, the valve allows the flow of fluid through a second fluid passage.

Claim 10, as amended, is directed to a fill tool for a casing. The fill tool includes a body having an internal passage leading to at least one outlet port adjacent a lower end of the body, an actuator that includes a plurality of scissor arms positioned about the body and adapted to laterally collapse upon insertion into the casing, and a movable sleeve positioned external to the internal passage, wherein the movable sleeve is movable between an open position and a closed position with respect to the at least one outlet port in response to the lateral movement of the actuator upon insertion into and substantial removal of the body from the casing.

Claim 15, as amended, is directed to a method for filling a well casing. The method includes:

(a) coupling a fill tool to a lower end of a tool string, the fill tool having: a first fluid passage; a movable sleeve in communication with the first fluid passage and positioned in a closed configuration about an exterior of the tool so as to block the flow of fluid through the first

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fluid passage; and an actuating device comprising a plurality of scissor arms coupled to the movable sleeve,

(b) lowering the tool into an opening of a well casing to actuate the actuating device by laterally collapsing the scissor arms thereby moving the movable sleeve to an open position so as to allow the flow of fluid through the first fluid passage, and

(c) injecting fluid into the tool string such that the fluid flows through the fluid passage.

Fournier '656 discloses a valve for use in an oilfield tool. Fournier '656 discloses at Column 4, lines 32-45 with reference to FIG. 3 that:

"The valve member 100 is movable between an open and a closed position. Generally, the open position permits fluid to enter and exit the tool 200 while the closed position prevents fluid from exiting the tool 200 by sealing a valve bore 115. In the open position, the valve bore 115 in the valve member 100 aligns with the upper bore 145 and the lower bore 175, thereby allowing fluid communication through the tool 200. Conversely, in the closed position, the valve member 100 is rotated approximately 90 degrees. As a result, the valve bore 115 is out of alignment with the bores 145, 175, thereby preventing the flow of fluid through the valve bore 115. In this manner, the valve member 100 selectively controls fluid communication through the tool 200."

Fournier '656, however, not provide any teaching, suggestion or motivation of a downhole tool that includes a movable sleeve for opening and closing a fluid passage and an actuating device coupled to a movable sleeve that includes scissor arms that are adapted to move laterally to cause the movable sleeve to move longitudinally from a closed position to an open position. Fournier '656 also does not provide any teaching, suggestion or motivation of a fill tool or a method for filling a well casing with a fill tool that includes an actuator having a plurality of scissor arms that are adapted to laterally collapse so as to move a sleeve between an open position and a closed position in response to the lateral movement of the actuator. Instead and as noted above, Fournier '656 discloses a valve member 100 that is opened and closed by means of rotation so as to control the flow of fluid through the valve bore 115. In addition, it is notable that a rotatable valve such as disclosed in Fournier '656 cannot be actuated with scissor arms.

Newman '703 discloses a wellbore tractor and method of moving an item through a wellbore. Newman '703 discloses at column 5, lines 50-69 that the wellbore tractor includes slip arms 131 and 132 which are secured to a slip 123. Newman '703, however, does not provide any teaching, suggestion or motivation of a downhole tool that includes a tubular housing having a first fluid passage, a movable sleeve for opening and closing the first fluid passage and a valve

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in communication with the first fluid passage wherein the valve allows the flow of fluid through a second fluid passage upon the occurrence of a predetermined condition. Newman '703 also does not provide any teaching, suggestion or motivation of a fill tool or a method for filling a well casing with a fill tool that includes a body having an internal passage leading to an outlet port and a movable sleeve positioned external to the internal passage that is movable between an open position and a closed position with respect to the outlet port.

Accordingly, neither Fournier '656 nor Newman '703, alone or in combination discloses or suggests all of the elements of claims 1, 10 or 15. Thus, for at least this reason, a prima facie case of obviousness has not been met with respect to claims 1, 10 and 15 because at least one of the criteria of the prima facie case has failed.

In addition, the remaining criteria of a prima facie case of obviousness have also not been met. There is no suggestion or motivation, either in Fournier '656 or Newman '703, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Indeed as noted above, the knowledge generally available to one of ordinary skill in the art would not lead to the combination of Fournier '656 and Newman '703 as suggested in the Office action because a rotatable valve such as disclosed in Fournier '656 cannot be actuated with a slip and slip arm arrangement such as disclosed in Newman '703. Consequently, there could be no reasonable expectation of success that a combination of Fournier '656 and Newman '703, would result in the subject matter of claims 1, 10 and 15, in part because the knowledge generally available to one of ordinary skill in the art would dictate against the combination, and, even if the references could be combined, neither reference discloses or suggests all of the elements of claims 1, 10 and 15.

Accordingly, there is no suggestion or motivation to combine or modify Fournier '656 or Newman '703 to accomplish the tools of claims 1 and 10 or the method of claim 15, and even further, there is clearly no suggestion or motivation to modify Fournier '656 or Newman '703 to provide the elements of claims 1, 10 and 15 noted above as lacking in their disclosures. The Office Action does not recite any particular evidence that would provide the teaching or suggestion that is lacking in the references. In this regard, MPEP § 2143.01 provides that:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.
MPEP § 2143.01 at 2100-126.

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In the absence of a teaching or suggestion of combination in the references themselves, as well as the absence of other particular evidence teaching or suggesting the combination, Applicants can only conclude that the suggestion or motivation for the combination of Fournier '656 and Newman '703 applied in the Office Action arises solely from impermissible hindsight.

Even if there were a suggestion or motivation to combine the references, the combination would not result in or be the equivalent of claims 1, 10 or 15 because neither reference discloses or suggests all of the elements of claims 1, 10 and 15. Accordingly, there could be no reasonable expectation of success for a combination of Fournier '656 and Newman '703.

In view of the foregoing, Applicant submits that a prima facie case of obviousness over Fournier '656 in view of Newman '703 has not been made with respect to claims 1, 10 and 15, and requests that the rejection of claims 1, 10 and 15 over these references be withdrawn. Claims 2-3, 5, 9, 12-14 and 16-17 which also stand rejected over Fournier '656 in view of Newman '703, depend from claims 1, 10 or 15. Accordingly, Applicant further requests that the rejection of claims 2-3, 5, 9, 12-14 and 16-17 over these references be withdrawn for at least the same reasons as apply to claims 1, 10 and 15.

Claims 7-8 stand rejected under 35 U.S.C. §103(a) over Fournier '656 in view of Newman '703 and further in view of U.S. Patent No. 4,067,358 to Streich ("Streich '358"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

According to MPEP § 2142, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP § 2142 at 2100-124. If even one of these criteria is not met, then the prima facie case fails.

Claims 7-8 depend from and include the subject matter of claim 1 noted above. Claims 7-8 specify that the valve of claim 1 includes an entrance port of the second fluid passage, a ball or a plunger and a biasing mechanism.

The deficiencies of Fournier '656 and Newman '703 with respect to claim 1 are noted above. In addition, as acknowledged in the Office action, neither Fournier '656 nor Newman

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'703 provide any teaching, suggestion or motivation of a downhole tool that includes a spring biased ball or plunger valve.

Streich '358 discloses an indexing automatic fill-up float valve. Streich '358, however, does not supply the deficiencies of Fournier '656 and Newman '703 with respect to claim 1. In addition, the Office action suggests that the valve of Streich '358 could replace the ball valve of Fournier '656. Assuming that such a substitution could be made, the substitution would destroy the utility of the valve of Fournier '656. Specifically, if the valve of Streich '358 replaced the ball valve of Fournier '656, the valve of Fournier '656 could only be moved from a closed to an open position by imposition of sufficient fluid pressure and not in response to insertion of the tool into casing. In this regard, see Column 5, lines 6-10 of Fournier '656 which discloses that:

"The handle 155 is constructed and arranged of weighted material to open the valve member 100 only when the tool 200 is inserted into casing and to close the valve member 100 after the tool 200 is removed from the casing."

Accordingly, none of Fournier '656, Newman '703 or Streich '358, alone or in combination disclose or suggest all of the elements of claims 7-8. Thus, for at least this reason, a prima facie case of obviousness has not been met with respect to claims 7-8 because at least one of the criteria of the prima facie case has failed.

In addition, the remaining criteria of a prima facie case of obviousness have also not been met. There is no suggestion or motivation, in any of Fournier '656, Newman '703 or Streich '358, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Consequently, there could be no reasonable expectation of success that a combination of Fournier '656, Newman '703 and Streich '358, would result in the subject matter of claims 7-8, in part because the knowledge generally available to one of ordinary skill in the art would dictate against the combination and even if the references could be combined, none of the references discloses or suggests all of the elements of claims 7-8.

Accordingly, there is no suggestion or motivation to combine or modify Fournier '656, Newman '703 and Streich '358 to accomplish the tool of claims 7-8, and even further, there is clearly no suggestion or motivation to modify Fournier '656, Newman '703 or Streich '358 to provide the elements of claims 7-8 noted above as lacking in their disclosures. The Office Action does not recite any particular evidence that would provide the teaching or suggestion that is lacking in the references. In this regard, MPEP § 2143.01 provides that:

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The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.
MPEP§ 2143.01 at 2100-126.

In the absence of a teaching or suggestion of combination in the references themselves, as well as the absence of other particular evidence teaching or suggesting the combination, Applicants can only conclude that the suggestion or motivation for the combination of Fournier '656, Newman '703 and Streich '358 applied in the Office Action arises solely from impermissible hindsight.

Even if there were a suggestion or motivation to combine the references, the combination would not result in or be the equivalent of claims 7-8 because none of the references discloses or suggests all of the elements of claims 7-8. Accordingly, there could be no reasonable expectation of success for a combination of Fournier '656, Newman '703 and Streich '358.

In view of the foregoing, Applicant submits that a prima facie case of obviousness over Fournier '656 in view of Newman '703 and further in view of Streich '358 has not been made with respect to claims 7-8, and requests that the rejection of claims 7-8 over these references be withdrawn.

IV. CONCLUSION

Claims 1-17 are now pending in the present application. In view of the foregoing remarks, allowance of claims 1-17 is respectfully requested. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,


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